

REMARKS/ARGUMENTS

The amendment filed was considered non-compliant because Claim 51 did not show the changes made. The listing of claims has been resubmitted, including a marked-up version of Claim 51. Also included below is a resubmission of the various remarks and arguments that were put forth in Applicant's last communication, but not considered by the Examiner.

The Examiner has rejected claims 48-53 and 77 under 35 U.S.C. 103(a) as being unpatentable over Lorber, U.S. Pat. No. 6,003,254 in view of Dawson, U.S. Pat. No. 5,761,836. As noted by the Examiner, Lorber teaches a greeting card that includes a pocket for receiving a record, along with an opening through which to view the record label. Dawson teaches a greeting card that plays an aural message upon opening, and may include slots for the insertion of gift items, such as lottery tickets, compact discs, photographs, credit cards or the like. Dawson also teaches that the automatic aural message may be complementary to the occasion marked by the card.

Neither Lorber, nor Dawson, alone or in combination, teaches all of the elements claimed by applicant. With respect to applicant's claims 50-53 and 77, applicant's invention comprises the combination of a card that includes a machine readable storage medium bearing indicia that is thematically related to the card body indicia. This is not taught by any combination of the referenced citations.

The only references to indicia taught by Lorber is within the summary, in column 1, lines 42-45: "It is the object of this invention to provide a greeting card when

combined with a record sleeve can receive a prerecorded audio disc reflecting a portion of the greeting card indicia." This object of the invention is ambiguous at best. As such, an ambiguous teaching can not be said to provide an invalidating teaching.

Dawson teaches away from the concept of thematically related indicia between the card body indicia and the thematic indicia located upon the machine readable storage medium. Although the aural message taught by Dawson may be related to the indicia of the card, Dawson does not teach that the gift item contained within the card is to be related to the card body indicia. To the contrary, if the gift item is a lottery scratch card, ticket, or photograph, etc. the gift item would specifically not be thematically related to the indicia of the card body itself. In any event, such a thematic relation is specifically not taught within Dawson.

Additionally, no mention is made in either Lorber, nor Dawson, as to a machine readable storage medium that contains data that is also thematically related to the indicia. Neither prior art reference teaches the inclusion of a stored data that is thematically related to the card body indicia, nor is this limitation brought forth by the Examiner.

With these points in mind, it will be noted that the dependency of the subsequent claims renders them suitable for allowance in light of the fact that the dependent claims add further limitations to the independent claims. For example, the Examiner has rejected claims 54-71 under 35 U.S.C. 103(a) as being unpatentable over Lorber in combination with Dawson and in view of Bradley, U.S. Pat. No. 5,946,834.

The addition of the teachings of Bradley, with respect to die-cutting and folding is irrelevant when combined with Lorber and Dawson based on the above remarks and arguments concerning the shortcomings of the teachings found in Lorber and Dawson.

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However, in order to put forth a complete response to Examiner's rejections, applicant responds that it is not merely the use of die-cutting that embodies the novelty of applicant's invention. Rather, it is the use of die-cutting to achieve the unique result that embodies applicant's specific configuration for the disclosed card assembly. The Examiner correctly notes that die-cutting could be used to accurately form the body of applicant's invention in the exact desired formation, however, it is precisely that exact desired formation that the addition of the use of die-cutting further limits.

The addition of Hodes, U.S. Pat. Appl. Publication No. 2002/0088855 is cited by the Examiner to reject claims 72-76, 78-81. Applicant acknowledges that Hodes teaches the addition of a gift card in such a way that the machine readable portion may be scanned or processed. Applicant, therefore, responds simply that the addition of the gift card in the aforementioned manner would be obvious standing alone; but when considered in their current dependent claim form, claims 72-81 are properly suited for allowance.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Patrick D. Archibald, Applicant's Attorney at (617) 720-0091 so that such issues may be resolved as expeditiously as possible.

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For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited. Reconsideration and further examination is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 12-0115.

In the event that an extension of time is required to file this response, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 12-0115.

Respectfully Submitted,

May 16, 2005 Patrick D. Archibald
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